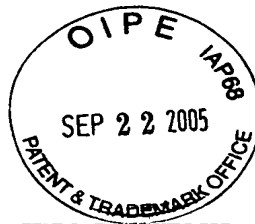


DOCKET NO.: 242939US90/ims



IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Sung Uk MOON, et al.

SERIAL NO: 10/663,785

GROUP: 2681

FILED: September 17, 2003

EXAMINER:

FOR: RADIO COMMUNICATION SYSTEM, MOBILE STATION AND RADIO
NETWORK CONTROLLER

LETTER

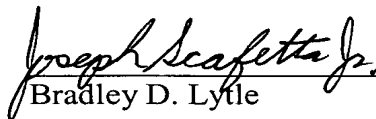
Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a People's Republic of China Office Action for the Examiner's consideration. The reference cited therein has been previously filed on February 5, 2004.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle

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Joseph Scaretta, Jr.
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(OSMMN 10/04)

THE PATENT OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

| | | |
|--------------------|---|---|
| Applicant | NTT DOCOMO,INC | Issue Date September 19, 2003 |
| Agent | Dragon International Patent Office | |
| Application No. | 031574092 | |
| Title of Invention | RADIO COMMNICATION SYSTEM, MOBILE STATION AND RADIO NETWOTK CONTROLLER | |

THE NOTIFICATION OF THE FIRST OFFICE ACTION

1. ☒ In accordance with the Request for substantive examination, the examiner has made the examination on the above patent application based on the provision in paragraph 1, Article 35 of the PRC Patent Law.

☐ The Patent Office itself has decided to make a substantive examination for the above cited patent application based on the provision in paragraph 2, Article 35 of the PRC Patent Law.

2. ☒ The applicant requested to designate the filing date of

September 19, 2002 in the Patent Office of Japan as the priority date;
 _____ in the Patent Office of _____ as the priority date;
 _____ in the Patent Office of _____ as the priority date;
 _____ in the Patent Office of _____ as the priority date;
 _____ in the Patent Office of _____ as the priority date;

3. ☒ Examination is made based on the Chinese translation of the original filing document.

☐ Examination is made based on the following documentations.

Item(s) ____ of claims, page(s) ____ of description, page(s) ____ of drawings based on the original filing document filed on the filing date.

Item(s) ____ of claims, page(s) ____ of description, page(s) ____ of drawings filed on _____

Item(s) ____ of claims, page(s) ____ of description, page(s) ____ of drawings filed on _____.

☐ page(s) ____ of drawings based on the Chinese translation of the original filing document.
 Page(s) ____ of drawings based on the Chinese translation of attachment of international Preliminary Examination Report.

Page(s) ____ of drawings based on the amended documents that are submitted in accordance with Article 28 or 41 of the PCT.

Page(s) ____ of drawings based on the amended documents that are submitted in accordance with Article 51 of the Chinese Patent Law.

4. ☒ The notification is made under the search for the patent ability.

☒ The following reference materials have been cited in this notification (their serial numbers will be referred to in the following procedure);

| Serial Number | Number or Title of Reference Material | Publication Date (or Filing Date of A Conflict Patent Application) |
|---------------|---------------------------------------|--|
| 1 | US5530437A | 1996/06/25 |
| | | |

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5. The conclusion of the examination;

☐ In regard to the description;

- ☐ The subject matter of the present application is not accepted based on the Article 5 of the PRC Patent Law.
- ☐ The presentation of the description is not in conformity with the provision of Rule 26, Paragraph 3 of the Implementing Regulations of PRC Patent Law.
- ☐ The presentation of the description is not in conformity with the provision of Rule 18 of the Implementing Regulations of PRC Patent Law.

☒ In regard to the Claims:

- ☐ Claims _____ can not be allowed beyond the scope of the protection based on the Article 25 of the PRC Patent Law.
- ☒ Claim 3 do not belong to the definition of invention based on the provision of paragraph 1, Rule 2 of the Implementing Regulations of the PRC Patent Law.
- ☒ Claims 1,2 can not be allowed owing to lack of inventiveness based on the provision of paragraph 3, Article 22 of PRC Patent Law.
- ☐ Claims _____ can not be allowed owing to lack of practical applicability based on the provision of paragraph 4, Article 22 of PRC Patent Law.
- ☐ Claims _____ can not be allowed based on the provision of paragraph 4, Article 26 of PRC Patent Law.
- ☐ Claims _____ can not be allowed based on the provision of Rules 20 of the Implementing Regulations of the PRC Patent Law.
- ☐ Claims _____ can not be allowed based on the provision of Rules 21 of the Implementing Regulations of the PRC Patent Law.

The explanation of the conclusion is given in the attachment sheet in details

6. According to the above conclusion, it is considered that

- ☐ the applicant should amend the application documents based on the request in the text of notification .
- ☒ the applicant should state the reason on which the application can be accepted and amend the part that is indicated not to be conformity with the requirement, otherwise the application will be rejected.
- ☐ No subject matter in the application is accepted, said application will be rejected if the applicant does not make a statement or fail to make a statement.
- ☐ the application will be rejected if amendment of documents submitted by applicant goes beyond the scope of patent protection

7. The applicant is drawn attention to that

(1) In accordance with the provisions of Article 37 of the Chinese Patent Law, the applicant shall submit the observation within FOUR months from the date of receiving this notification. If the applicant, without any justified reason, fails to reply within the time limit, the application shall be

deemed to have been withdrawn.

(2) The applicant shall make amendments to what is not in conformity with the provisions in the text of this notification. The amended text shall be furnished in duplicate. The formality of the document should be in conformity with the relative provisions of the Guidebook for Examination.

(3) The applicant and/or his attorney could not go to the PRC Patent Office to meet the examiner if no appointment is made.

(4) Any response and/or amended specification must be mailed or sent by hand to the receiving Department of the PRC Patent Office. Any documents that are not sent to the Receiving Department do not have legal force.

8. The text of notification embraces 3 page(s), along with the enclosures herein:

☒ 1 copy of the cited references is enclosed in page of 16 .

Text of the Notification of the First Office Action

Application No: 03157409.2

After examination, the examiner's opinions on the application are provided as follows:

1. Claim 1 is not in conformity with the provision of Paragraph 3, Article 22 of the PRC Patent Law for lacking inventiveness.

reference 1 discloses a portable communication system and concretely discloses the following technical features: "fixed communication units 101 (equivalent to the base stations of the claim of the present application), portable communication units 108 (equivalent to the mobile stations of the claim), central controller 102 (equivalent to the radio network controller of the claim), wherein the central controller 102 comprises a processor, and an encoder/transmitter controller 414 used to transmit pages or messages to portable communication units 108 (equivalent to the control signal transmitter of the claim, and please refer to Figures 4 and 1), and refer to figures 5 and 6, it can be seen that the central processor divides a multicast group into subsets, and also divides a multicast group into control signals for the subsets, and transmits them to the fixed communication units 101 (refer to 1.42, col.6 to 1.36, col.10 of the description and claim 8); at the same time, portable communication 108 transmits the response signal to the fixed communication units, and the operating parameters of the received messages from transmitter 104 including response time 224 for controlling the initial time of the response (since the received message comprises the response time, portable communication units 108 that receive the message consequently comprise a device for detecting the response time so as to detect the designation time, such that portable communication units 108 transmit the response at the response time), and moreover, receivers 103 and 105

receive the response from the subsets of portable communication units 108 (the receivers receive the response from the subsets of the communication units, it is thus certainly that the transmitter units of portable communication units 108 transmit the response, so portable communication units 108 consequently comprise the response signal transmitter)" (refer to 1.11 to 1.65, col.5, 1. 42 to col.10, 1.36, col.6 of the description, claim 8 and Figures 2 , 4 , 5 and 6). It can be seen that, although the expression way of reference 1 is different from that of claim 1, most of technical features of claim 1 have been disclosed in reference 1. The distinctive technical solution of claim 1 is only on the "response signal creator" which is not mentioned in reference 1, but portable communication units 108 transmit the response signal to the fixed communication units, and it is thus obvious that the response consequently is created in portable communication units 108 and then the units certainly comprise a response signal creator. This difference is a general knowledge. And it is obvious for a person skilled in the art to obtain the technical solution of claim 1 by combining the general knowledge on the basis of reference 1. Therefore, claim 1 has not prominent substantive features and does not represent a notable progress and thus does not possess inventiveness.

2. Claim 2 is not in conformity with the provision of Paragraph 3, Article 22 of the PRC Patent Law for lacking inventiveness.

Reference 1 discloses a portable communication system, and concretely discloses the following technical features: "portable communication units 108 (equivalent to the mobile stations of claim 2 of the present application), a response signal to the fixed communication units, and the operating parameters of the received messages from transmitter 104 comprise response time 224 for controlling the initial time of the response (since the received message comprises the response time,

and portable communication units 108 that receive the message consequently comprise a device for detecting the response time so as to detect the designation time, such that portable communication units 108 transmit the response at the response time), and receivers 103 and 105 receive the response from the subsets of the portable communication units (the receivers receive the response from the subsets of the communication units, it is thus certainly that the transmitter units of portable communication units 108 transmit the response, so portable communication units 108 consequently comprise the response signal transmitter)” (refer to 1.11 to 1.65, col.5, 1.36, col.8 of the description of reference 1 and claim 8). It can be seen that, although the expression way of reference 1 is different from that of claim 1, the reference 1 most of technical features have been disclosed in claim 1, the distinctive technical solution asked for protection in claim 1 is only on the “response signal creator” which is not mentioned in reference 1, but transmit the response signal to the fixed communication units and it is thus obvious that the response consequently is created in the portable communication units 108 and then the units certainly comprise a response signal creator. This difference is a general knowledge. And it is obvious for a person skilled in the art to obtain the technical solution of claim 2 by combining the general knowledge on the basis of reference 1. Therefore, claim 2 has not prominent substantive features and does not represent a notable progress and thus does not possess inventiveness.

3. Claim 3 is not in conformity with the provision of Paragraph 2, Article 22 of the PRC Patent Law for lacking novelty.

Reference 1 discloses a central controller, and concretely discloses the following technical features: “central controller 102 (equivalent to the radio network controller of claim 3 of the present application) comprises a processor and encoder/transmitter controller 414 for interfacing

transmitter 104 for transmitting pages and messages to portable communication 108 (equivalent to the control signal transmitter, please refer to Figures 4 and 1 of reference 1), from figures 5 and 6, it can be seen that the central processor divides a multicast group into subsets, and also divides a multicast group into control signals for the subsets, and transmits them to fixed communication units 101 (refer to 1.42, col.6 to 1.36, col.10 of the description and claim 8). It can be seen that the difference between the technical solution asked for protection in the claim and the content disclosed by reference 1 is only on the literal expression, and the technical solutions are substantially same, and both belong to the same technical field and resolve the same technical problem to obtain the same technical effect. Therefore, claim 3 does not possess novelty.

4. If the applicant deletes the two claims when replying the first office action for lacking inventiveness, in that claims 1 and 2 are not in conformity with the provision of Paragraph 3, Article 22 of the PRC Patent Law for lacking inventiveness, the title of the invention should be amended correspondingly so that the new title of the invention is consistent with the subject protected by the invention.

The applicant should reply all the items provided in the Notification within the time limit specified in the Notification, otherwise, the present applicant cannot be granted a patent right. The amendment to the application documents shall comply with the provision of Article 33 of the PRC Patent Law and shall not go beyond the scope of contents disclosed in the original specification and claims.



中华人民共和国国家知识产权局

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|--|--|----------|
| 邮政编码: 100029 北京市朝阳区裕民路 12 号中国国际科技会展中心 A1210 号 北京银龙知识产权代理有限公司 徐川 | | 发文日期 |
| 申请号: 031574092 | | |
| 申请人: 株式会社 NTT 都科摩 | | |
| 发明创造名称: 无线通信系统, 移动台及无线网络控制器 | | |

第一次审查意见通知书

- ☒ 应申请人提出的实审请求, 根据专利法第 35 条第 1 款的规定, 国家知识产权局对上述发明专利申请进行实质审查。
☐ 根据专利法第 35 条第 2 款的规定, 国家知识产权局决定自行对上述发明专利申请进行审查。
- ☒ 申请人要求以在:

| | | | |
|----|---------|------------------|--------|
| JP | 专利局的申请日 | 2002 年 09 月 19 日 | 为优先权日, |
| | 专利局的申请日 | 年 月 日 | 为优先权日, |
| | 专利局的申请日 | 年 月 日 | 为优先权日, |
| | 专利局的申请日 | 年 月 日 | 为优先权日, |
| | 专利局的申请日 | 年 月 日 | 为优先权日, |

☒ 申请人已经提交了经原申请国受理机关证明的第一次提出的在先申请文件的副本。
☐ 申请人尚未提交经原申请国受理机关证明的第一次提出的在先申请文件的副本, 根据专利法第 30 条的规定视为未提出优先权要求。
- ☐ 经审查, 申请人于:

| | |
|----------|-------------------|
| 年 月 日提交的 | 不符合实施细则第 51 条的规定; |
| 年 月 日提交的 | 不符合专利法第 33 条的规定; |
| 年 月 日提交的 | |
- 审查针对的申请文件:

| | |
|---|---------------------------------------|
| <input checked="" type="checkbox"/> 原始申请文件。 | <input type="checkbox"/> 审查是针对下述申请文件的 |
| 申请日提交的原始申请文件的权利要求第 | 项、说明书第 页、附图第 页; |
| 年 月 日提交的权利要求第 | 项、说明书第 页、附图第 页; |
| 年 月 日提交的权利要求第 | 项、说明书第 页、附图第 页; |
| 年 月 日提交的权利要求第 | 项、说明书第 页、附图第 页; |
| 年 月 日提交的说明书摘要, | 年 月 日提交的摘要附图。 |
- ☐ 本通知书是在未进行检索的情况下作出的。
☒ 本通知书是在进行了检索的情况下作出的。
☒ 本通知书引用下述对比文献(其编号在今后的审查过程中继续沿用):

| | | |
|----|------------|------------------------|
| 编号 | 文件号或名称 | 公开日期 (或抵触申请的申请日) |
| 1 | US5530437A | 1996-6-25 FILED 2-5-04 |
- 审查的结论性意见:

| |
|---|
| <input type="checkbox"/> 关于说明书: |
| <input type="checkbox"/> 申请的内容属于专利法第 5 条规定的不授予专利权的范围。 |
| <input type="checkbox"/> 说明书不符合专利法第 26 条第 3 款的规定。 |

申请号 031574092

- ☐说明书不符合专利法第 33 条的规定。
☐说明书的撰写不符合实施细则第 18 条的规定。

☒关于权利要求书:

- | | | |
|--|------|------------------------------|
| <input checked="" type="checkbox"/> 权利要求 | 3 | 不具备专利法第 22 条第 2 款规定的新颖性。 |
| <input checked="" type="checkbox"/> 权利要求 | 1, 2 | 不具备专利法第 22 条第 3 款规定的创造性。 |
| <input checked="" type="checkbox"/> 权利要求 | | 不具备专利法第 22 条第 4 款规定的实用性。 |
| <input type="checkbox"/> 权利要求 | | 属于专利法第 25 条规定的不授予专利权的范围。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法第 26 条第 4 款的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法第 31 条第 1 款的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法第 33 条的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 2 条第 1 款关于发明的定义。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 13 条第 1 款的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 20 条的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 21 条的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 22 条的规定。 |
| <input type="checkbox"/> 权利要求 | | 不符合专利法实施细则第 23 条的规定。 |

上述结论性意见的具体分析见本通知书的正文部分。

7. 基于上述结论性意见, 审查员认为:

- ☐ 申请人应按照通知书正文部分提出的要求,对申请文件进行修改。
- ☒ 申请人应在意见陈述书中论述其专利申请可以被授予专利权的理由,并对通知书正文部分中指出的不符合规定之处进行修改,否则将不能授予专利权。
- ☐ 专利申请中没有可以被授予专利权的实质性内容,如果申请人没有陈述理由或者陈述理由不充分,其申请将被驳回。

8. 申请人应注意下述事项:

- (1) 根据专利法第 37 条的规定, 申请人应在收到本通知书之日起的肆个月内陈述意见, 如果申请人无正当理由逾期不答复, 其申请将被视为撤回。
- (2) 申请人对其申请的修改应符合专利法第 33 条的规定, 修改文本应一式两份, 其格式应符合审查指南的有关规定。
- (3) 申请人的意见陈述书和/或修改文本应邮寄或递交国家知识产权局专利局受理处, 凡未邮寄或递交给受理处的文件不具备法律效力。
- (4) 未经预约, 申请人和/或代理人不得前来国家知识产权局专利局与审查员举行会晤。

9. 本通知书正文部分共有 3 页,并附有下列附件:

- ☐引用的对比文件的复印件共 份 页。☐

审查员：罗世娜(3305)

2005 年 6 月 23 日

审查部门 通信审查部

第一次审查意见通知书正文

申请号：031574092

1. 权利要求1所要求保护的技术方案不具备专利法第二十二条第三款规定的创造性。对比文件1公开了一种便携无线通信系统，并具体公开了以下的技术特征“固定通信单元101(对应于该权利要求中的基站)，便携通信单元108(对应于该权利要求中的移动台)，中央控制器102(对应于该权利要求中的无线网络控制器)，其中，中央控制器102包括一个处理器装置，并且包括一个编码器/发射机控制器414用于与发射机104接口用于发射寻呼或者消息给便携通信单元108(这对应于该权利要求中的控制信号发射机，参见图4和图1)，并且参见图5、6可以看到，中央处理器也将多播通信集分成多个子集，并将多播通信集的控制信号分成子集的控制信号，并将其发射给固定通信单元101(参见说明书第6栏第42行至第10栏第36行、权利要求8)；同时，便携通信单元108发射响应信号给固定通信单元，并且在从发射机104中接收到的信息中的操作参数中包括响应定时224，用于控制响应的发出时间(由于在接收的信息中包含响应定时，那么接收该信息的便携通信单元108必然包括检测该响应定时的装置，来检测出定时，以便于便携通信单元108在该响应定时处发射该响应)，并且接收机103、105接收来自便携通信单元子集中的响应(接收机接收来自便携通信单元子集中的响应，那么必然由便携通信单元108中的发射单元来发射，因此，便携通信单元108必然也包含响应信号发射机)”(参见该对比文件的说明书第5栏第11行至第65行、第6栏第42行至第10栏第36行、权利要求8，附图2、4、5、6)。由此可见，虽然对比文件1的表达方式与权利要求1中略有不同，但是对比文件1公开了权利要求1的大部分特征，该权利要求所要求保护的技术方案与该对比文件所公开的技术内容相比，其区别仅在于“响应信号生成器”，然而虽然对比文件1中没有明确指出在便携通信单元108中包括响应信号生成器来生成响应信号，但是由于是便携通信单元108把响应信号发送给固定通信单元，那么该响应必然在便携通信单元108中产生并且该单元包括一个响应生成器是显而易见的，这种区别是一种公知常识。在该对比文件的基础上结合上述公知常识以获得该权利要求所要求保护的技术方案，对所属技术领域的技术人员来说是显而易见的，因此该权利要求所要求保护的技术方案不具备突出的实质性特点和显著的进步，因而不具备创造性。

2. 权利要求2所要求保护的技术方案不具备专利法第二十二条第三款规定的创造性。对比文件1公开了一种便携通信单元，并具体公开了以下的技术特征“便携通信单元108

(对应于该权利要求中的移动台)，便携通信单元108发射响应信号给固定通信单元，并且在从发射机104中接收到的信息中的操作参数中包括响应定时224，用于控制响应的发出时间(由于在接收的信息中包含响应定时，那么接收该信息的便携通信单元108必然包括检测该响应定时的装置，来检测出定时，以便于便携通信单元108在该响应定时处发射该响应)，并且接收机103、105接收来自便携通信单元子集中的响应(接收机接收来自便携通信单元子集中的响应，那么必然由便携通信单元108中的发射单元来发射，因此，便携通信单元108必然也包含响应信号发射机)~(参见该对比文件的说明书第5栏第11行至第65行、第8栏第3行至第10栏第36行、权利要求8)。由此可见，虽然对比文件1的表达方式与权利要求2中略有不同，但是对比文件1公开了权利要求1的大部分特征，该权利要求所要求保护的技术方案与该对比文件所公开的技术内容相比，其区别仅在于“响应信号生成器”，然而虽然对比文件1中没有明确指出在便携通信单元108中包括响应信号生成器来生成响应信号，但是由于是便携通信单元108把响应信号发送给固定通信单元，那么该响应必然在便携通信单元108中产生并且该单元包括一个响应生成器是显而易见的，这种区别是一种公知常识。在该对比文件的基础上结合上述公知常识以获得该权利要求所要求保护的技术方案，对所属技术领域的技术人员来说是显而易见的，因此该权利要求所要求保护的技术方案不具备突出的实质性特点和显著的进步，因而不具备创造性。

3. 权利要求3所要求保护的技术方案不具备专利法第二十二条第二款规定的新颖性。对比文件1公开了一种中央控制器，并具体公开了以下的技术特征“中央控制器102(对应于该权利要求中的无线网络控制器)，其中，中央控制器102包括一个处理器装置，并且包括一个编码器/发射机控制器414用于与发射机104接口用于发射寻呼或者消息给便携通信单元108(这对应于该权利要求中的控制信号发射机，参见图4和图1)，并且参见图5、6可以看到，中央处理器也将多播通信集分成多个子集，并将多播通信集的控制信号分成子集的控制信号，并将其发射给固定通信单元101(参见说明书第6栏第42行至第10栏第36行、权利要求8)。由此可见，该权利要求所要求保护的技术方案与该对比文件所公开的内容相比，所不同的仅仅是文字表达方式上略有差别，其技术方案实质上是相同的，且两者属于相同的技术领域，并能产生相同的技术效果，因此该权利要求所要求保护的技术方案不具备新颖性。

4. 由于权利要求1和2不具备专利法第二十二条第三款规定的创造性，因此如果申请人在答复一通时删除这两个权利要求后，则应该相应地修改发明名称，以使新的发明名

称与所保护的主体相一致。

申请人应当在本通知书指定的答复期限内对本通知书提出的问题逐一进行答复，修改专利申请文件，否则本申请将难以获得批准。申请人对申请文件的修改应当符合专利法第三十三条的规定，不得超出原说明书和权利要求书记载的范围。

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